

REMARKS/ARGUMENTS

The present Amendment is in response to the Office Action having a mailing date of March 3, 2006. Claims 1-19 are pending in the present Application. Applicant has amended claims 1-18. Consequently, claims 1-19 remain pending in the present Application.

Applicant has amended claims 1-18 to remove alphanumeric designations of the steps of each claims. This amendment is seen by Applicant as broadening or cosmetic, and as such, is not subject to the prosecution history estoppel imposed by Festo. For the record, Applicant points out that the Supreme Court in Festo noted that a cosmetic amendment would not narrow the patent's scope and thus would not raise the estoppel bar. Applicant has also amended claims 1 and 10 to recite that the defaults are displayed to a customer. Support for the amendment can be found in the specification page 10, lines 20-22.

In the above-identified Office Action, the Examiner rejected claims 1-18 under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. In so doing, the Examiner indicated that applicant "fails to fully describe the mathematical process as to how a default system is determined."

Applicant respectfully traverses the Examiner's rejection. The discussion of Figure 3 of the present application, in paragraph 18, indicates that the defaults provided are based upon the selections made by the user. The specification further clarifies this in Figure 4 and the accompanying discussion in paragraphs 20-27. In particular, the specification states:

A plurality of performance levels for one or more components of the product are provided to the customer, via step 158. In a preferred embodiment, step 158 is performed by displaying the available processor on the display 12. Each of the processors has a particular speed and thus a particular level of performance. The customer selects the performance level for one or more of the components, via step 160.

Performance variables are provided based on the level of performance selected, via step 162. **In a preferred embodiment, the performance variable is a rating based upon the speed of the processor. If the processors can be considered to be $n, n+1, n+2, \dots, n+i$, with n having the lowest speed and $n+i$ having the highest speed, then the performance variable are preferably from 0.1 to 1, where each value is correlated to one of $n, n+1, n+2, \dots, n+i$. For example, the performance value of 0.1 may correlate to a processor speed n .**

The components for the product are also validated against existing inventory, via step 164. Step 164 is preferably performed by providing inventory variables for the components that may be placed in the default offering. **In a preferred embodiment, step 164 is performed by checking the inventory for the components and providing an inventory variable of between 0.1 and 1.0 for each component.** However, the inventory variables could be provided for a portion of the components of the product. An inventory variable of 0.1 indicates that the item is low on stock, while an inventory variable of approximately 1.0 indicates that the item is available.

One or more default offerings for the product are dynamically determined using the segment variables, the performance variables and the inventory variables, via step 166. Step 166 is preferably performed by multiplying the segment variable, inventory variable and, where applicable, performance variable for each decision required in providing the default offering. For example, if the product being offered is a computer system and a particular frame is to be provided in the default offering, then the variables will be multiplied for each frame type. **The frame type (mini-tower, tower or desktop) having the highest score is made part of the default offering. If multiple default offerings are to be provided, then lower scores may be made part of the other default offerings. Thus, the default offerings can be built component by component in step 166.**

Specification page 9, line 15-page 10, line 19 (emphasis added).

Thus, the specification states that each selection by a user corresponds to variables for different products. These variables are multiplied and the highest score(s) are provided as the default(s). Moreover, specific examples of variables, such as 0.1 for an item that is low in stock and a 1.0 for an item that is in stock, are given. The specification further states that these values may be multiplied to provide a score and, based on the score, defaults may be provided. Thus, Applicant respectfully submits that the specification does adequately describe the invention as

recited in claims 1-18. Accordingly, Applicant respectfully submits that claims 1-18 comply with the enablement requirement of 35 U.S.C. § 112, first paragraph.

In the above-identified Office Action, the Examiner rejected claims 1-18 under 35 U.S.C. § 101 because the number assigned to the segment variables are subjective and, therefore, fails to produce a concrete result.

Applicant respectfully traverses the Examiner's rejection. As discussed above, specific variable amounts in particular embodiments are described. In particular, a low value (for example 0.1 for a product low in inventory) and a high value (for example 1 for an in stock product) are described. As described in the cited portion of the specification above, the user does not select the values for each selection made. Instead, the values are selected by the vendor based upon the vendor's priorities. Thus, based upon the customer's selections, for example the business segment and performance level, variables corresponding to the selections and products offered are automatically determined. Consequently, the customer's selection of the same business segment and product under the same conditions (such as the same inventory levels) would be the same, predictable result. Thus, although the method, computer-readable medium and system may be flexible enough for different vendors, they also operate without undue experimentation.

Accordingly, Applicant respectfully submits that claims 1-18 are allowable under 35 U.S.C. § 101.

In the above-identified Office Action, the Examiner rejected claims 1-19 under 35 U.S.C. § 103 as being unpatentable over U.S. Patent No. 6,167,383 (Henson) in view of U.S. Patent No. 5,668,997 (Lynch-Freshner).

Applicant respectfully traverses the Examiner's rejection. Claim 1 recites a method for providing a default offering for a product. The product is offered in a plurality of business segments and includes a plurality of components. The method recited in claim 1 includes

allowing a customer to select business segment(s) and performance level(s) for the component(s). The method of claim 1 further recites dynamically determining at least one default offering determined based on the at least one business segment and the at least one performance level and providing the default offering(s) to the customer based on the selections. Claims 10 and 19 recite an analogous computer-readable medium and computer-system, respectively.

Applicant agrees that Henson describes a system that allows a user to select a business with which the customer is associated. However, Henson teaches that the customer is allowed to make such a selection upon *checkout*. Henson, col. 11, lines 10-11 and 63-67 and col. 13, lines 6-33. For example, Henson states that the type of use (business or personal) is selected for subsequent routing to a sales force. Henson, col. 13, lines 6-17. Applicant can find no indication that the selection of a type of use or business segment is utilized in determining which defaults are to be offered to the customer in selecting the system for purchase. Similarly, as the Examiner has acknowledged, Henson does not teach or suggest utilizing a performance level to present the user with a default system. Consequently, Henson alone fails to teach or suggest the method, computer-readable medium and system recited in claims 1, 10, and 19.

Lynch-Freshner fails to remedy the defects of Henson. Lynch-Freshner does describe a system that accepts parameters from a client and produces a window based on these parameters. However, Applicant can find no indication in Lynch-Freshner or Henson that the parameters accepted can or should be include a business segment or performance level. Furthermore, Applicant has found no indication in Lynch-Freshner or Henson that the window provided based on the selected parameters can or should be the default offerings to a customer. Consequently, any combination of Henson and Lynch-Freshner would also fail to teach or suggest these features. Stated differently, Applicant respectfully submits that in allowing the customer to input

information and providing an output, for example the checkout windows described in FIGS. 7-10 of Henson accept input and provide a new window. For example, the windows depicted in FIGS. 7 and 8 accept input for the first of five steps, FIG. 9 for the second step, and so on. Thus, to the extent that Henson accepts input and provides new windows in response to the input, Henson already incorporates the teachings of Lynch-Freshner. Consequently, the combination fails to teach or suggest the method and system recited in claims 1, 10, and 19.

Moreover, Applicant respectfully submits that the concluding that Henson in combination with Lynch-Freshner teaches the inventions recited in claims 1, 10, and 19 involves improper hindsight. One “cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention.” In re Fine, 5 USPQ2d 1596, 1600 (Fed. Cir. 1988). See also In re Fritch, 23 USPQ2d 1780, 1783 (Fed. Cir. 1992). Moreover, most inventions arise from a combination of old elements and each element may often be found in the prior art. Rouffett, 149 F.3d at 1357. However, mere identification in the prior art of each element is insufficient to defeat the patentability of the combined subject matter as a whole. Id. at 1355, 1357. Accordingly, Applicant respectfully submits that claims 1, 10, and 19 are allowable over the cited references.

Claims 2-9 and 11-18 depend upon independent claims 1 and 10, respectively. Consequently, the arguments herein apply with full force to claims 2-9 and 11-18. Accordingly, Applicant respectfully submits that claims 2-9 and 11-18 are allowable over the cited references.

Applicant's attorney believes that this application is in condition for allowance. Should any unresolved issues remain, Examiner is invited to call Applicant's attorney at the telephone number indicated below.

Respectfully submitted,

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Date

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